

REMARKS/ARGUMENTS

This is in response to the Final Office action of December 22, 2008. For reasons discussed below, the Applicants believe this Final Office action should have been a First Office action on the merits and thus are responding herein as if the Office action was not improperly finally rejected.

By the foregoing amendment, claims 1 and 11 are cancelled without prejudice. Claims 2-10, which previously depended from claim 1, now depend from claim 12. New claims 14 and 15 are added by the foregoing amendment, wherein new claim 14 depends from amended claim 13 and new claim 15 depends from claim 12. Thus, claims 2-10 and 12-15 are pending in the instant application.

The Applicants first traverse the Examiner's decision to finally reject the RCE Application on a first Office action under MPEP 716.07(b). Under MPEP 706.07(b),

"The claims of an application for which a request for continued examination (RCE) has been filed may be finally rejected in the action immediately subsequent to the filing of the RCE (with a submission and fee under 37 CFR 1.114) where all the claims in the application after the entry of the submission under 37 CFR 1.114 (A) are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114, and (B) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to the filing of the RCE under 37 CFR 1.114."

Thus, a final rejection may be mailed where two separate requirements are satisfied, namely where (1) all the claims in the RCE are the same as claimed as in the

prior application and (2) where all the claims would have been properly finally rejected if they had been entered.

Claim 13, with a new limitation not previously presented (namely “reintroducing said at least one of said plurality of metallic cathodes to said electrochemical cell assembly”), was added in conjunction with the Applicants’ response and RCE on November 24, 2008. Thus, claim 13 is not drawn to the same invention as claims previously presented. As such, the decision to make this action FINAL is improper under MPEP 706.07(b). Removal of the FINAL rejection of the instant application is thus respectfully requested.

Claims 1-4, 8-10, 12 and new claim 13 currently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 4,445,990) in view of Carlson (U.S. Patent No. 3,650,925) for reasons of record. Claims 5-7 and 11 also currently stand rejected under 35 U.S.C. 103(a) as being unpatentable over Kim (U.S. Patent No. 4,445,990) in view of Carlson (U.S. Patent No. 3,650,925) and further in view of de Nora et al. (U.S. Patent No. 4,834,850) for reasons of record. The Applicants respectfully traverse the Examiner’s rejection.

As stated above, the Applicants have first cancelled claims 1 and 11. Thus, the rejections of claims 1 and 11 are now moot.

Claim 12 of the instant application, and dependent claims 2-10 and 15 there from, each claim "wherein a permeable ceramic diaphragm is used to separate the anodes and cathodes". Neither Kim, nor Carlson, nor de Nora, alone or in combination, discloses a permeable ceramic diaphragm. As such, claim 12, and dependent claims 2-10 and 15, are not obvious over any combination of the cited references. Moreover, with respect to new claim 15, none of the cited references discloses "cutting said fractured pieces of the deposited metal into smaller pieces prior to utilizing said fractured pieces as said source of metal ions in said electrochemical deposition of the metal". For this additional reason, claim 15 is not obviated by any combination of the cited references. Reconsideration of claims 2-10, 12 and 15 are thus respectfully requested.

Amended claim 13 of the instant application, and dependent claim 14 there from, each claim the following elements: (1) "removing said at least one of said plurality of metallic cathodes from said electrochemical cell assembly"; (2) "recovering said portion of said metal ions from said at least one of said plurality of metallic cathodes by fracturing said deposited portion into pieces"; (3) "using said fractured recovered portions of said metal ions as a source of metal to be deposited onto a substrate in a subsequent metal plating process"; and (4) "reintroducing said at least one of said plurality of metallic cathodes without said recovered portion of said metal ions to said electrochemical cell assembly." None of the cited references, alone or in combination, disclose each of these four elements. As such, claims 13 and 14 are not obviated by any combination of the cited references. Moreover, with respect to new claim 14, none of the cited references discloses "cutting said fractured pieces of the deposited metal into

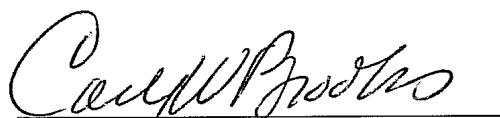
smaller pieces prior to utilizing said fractured pieces as said source of metal ions in said electrochemical deposition of the metal". For this additional reason, claim 14 is not obviated by any combination of the cited references. Reconsideration of claims 13 and 14 are thus respectfully requested.

In view of the above comments, it would appear that the application is conditioned for allowance and a notification of allowance is respectfully requested. Should the examiner have any questions with respect to the application and /or of this amendment, he may contact the undersigned by calling collect.

In the event that any new fees or charges are required, authorization is hereby given to charge such fees to applicant's Deposit Account No 50-0852.

Respectfully submitted,

REISING, ETHINGTON, BARNES, KISSELLE, P.C.



Cary W. Brooks
Registration No. 33,361
P. O. Box 4390
Troy, MI 48099-4390
(248) 689-3500

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